REMARKS

The Applicant has received the Office Action dated May 4, 2004, (hereinafter "Paper No. 3"), in which the Examiner: (1) rejected claims 1-32 under 35 U.S.C. § 101 as allegedly drawn to an abstract idea; (2) rejected claim 6 under 35 U.S.C. § 112 as allegedly not enabled; (3) rejected claims 1-24, 26-29, and 31 under 35 U.S.C. § 102(b) as allegedly anticipated by Nomura et al. (U.S. Pat. No. 5,740,323, hereinafter "Nomura"); (4) rejected claims 1-32 under § 102(b) as allegedly anticipated by Terano et al., (hereinafter "Terano"); (5) rejected claims 1-24, 26-29, and 31 under 35 U.S.C. § 102(e) as allegedly anticipated by Martinka et al. (U.S. Pat. No. 6,591,257, hereinafter "Martinka"); and (6) rejected claims 25, 30, and 32 under 35 U.S.C. § 103(a) as allegedly obvious in light of Nomura, in view of Terano and further in view of information from the Applicant's disclosure. Each of the Examiner's rejections will be dealt with in detail below.

In this response, the Applicant has amended claims 1, 4, 13, 21 and 26, and added new claims 33-38. Furthermore, the Applicant has amended the Specification at page 9, line 24 to correct a clerical error. The Applicant respectfully submits that no new matter is added by these amendments and requests reconsideration of the present application.

I. Rejection Under 35 U.S.C. § 101

As mentioned above, the Examiner rejected claims 1-32 as drawn to "abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result ...." Paper No. 3, page 2. The Applicant respectfully disagrees with the reasoning used by the Examiner in support

of the § 101 rejection. Furthermore, the Applicant respectfully traverses the § 101 rejections because the pending claims are directed to statutory subject matter.

A. Failure to Fall within the Technological Arts is NOT a basis for a § 101 Rejection

The Applicant respectfully asserts that the Examiner's assertion that patentable subject matter must fall within the "technological arts" is unfounded. Although there is no legal authority cited by the Examiner in support of the "technological arts" argument, this rejection was first enunciated in *In re Musgrave*, 431 F.2d 882, 893, 167 U.S.P.Q. 280, 289 (C.C.P.A. 1970) (holding that all that is necessary to make a sequence of operational steps a statutory "process" within 35 U.S.C. § 101 is that it be in the technological arts); *see also In re Benson*, 441 F.2d 682, 688, 169 U.S.P.Q. 548 (C.C.P.A. 1971) (holding that computers were within the technological arts and thus were statutory subject matter). Furthermore, the Court of Claims and Patent Appeals, in reviewing the language of *In re Musgrave*, *In re Benson*, and *Gottschalk v. Benson*, rejected the notion that the "technological arts" rejection created or formed a basis for a § 101 rejection. *See In re Toma*, 197 U.S.P.Q. 852 (C.C.P.A. 1978). That is, a "technological arts" rejection was not intended to create a generalized definition of statutory subject matter. *See id.* at 857. Accordingly, the Applicant respectfully asserts that the instant claims are directed to patentable subject matter because there is no "technological arts" definition of statutory subject matter.

B. The Present Claims are Directed to Statutory Subject Matter

Any analysis of whether a claim is directed to statutory subject matter begins with the language of 35 U.S.C. § 101, which reads:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In interpreting this section, the Supreme Court stated that Congress intended statutory subject matter to "include *anything* under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 309, 206 U.S.P.Q. 193, 197 (1980) (emphasis added). Although this statement may appear limitless, the Supreme Court has identified three categories of unpatentable subject matter: laws of nature, natural phenomena, and abstract ideas. *See, Diamond v. Diehr*, 450 U.S. 175, 182, 209 U.S.P.Q. 1, 7 (1981). Accordingly, so long as a claim is not directed to one of the three specific areas listed above, the claim is directed to patentable subject matter. Thus, it is improper to read into Section 101 regarding subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitation. *In re Alappat*, 31 U.S.P.Q.2d 1545, 1556 (Fed. Cir. 1994) (citing *Chakrabarty* 447 U.S. at 308).

For example, the fact that a claim includes or is directed to an algorithm is no ground for holding a claim is directed to non-statutory subject matter. *See, In re Iwashashi*, 12 U.S.P.Q.2d 1908, 1911 (Fed. Cir 1989). Rather, the proscription against patenting an algorithm, to the extent it still exists, is narrowly limited to *mathematical algorithms in the abstract*, e.g., describing a mathematical algorithm as a procedure for solving a given type of mathematical problem. *See, AT&T Corp. v. Excel Communications, Inc.*, 50 U.S.P.Q.2d 1447, 1450 (Fed. Cir 1999). Indeed, the courts are aware that any step-by-step process, be it electronic, chemical, or mechanical, involves an algorithm. *Id.* at 1450.

Thus, inquiry into what is statutory subject matter simply requires "an examination of the contested claims to see if the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a 'law of nature' or an 'abstract idea, or if the mathematical concept has been reduced to some practical application rendering it 'useful'." *Id.* at 1451 (citing and quoting *In re Alappat*, 31 U.S.P.Q.2d at 1557). Furthermore, a Section 101 analysis "demands that the focus in any statutory subject matter analysis be on the *claim as a whole.*" *In re Alappat*, 31 U.S.P.Q.2d at 1557 (citing *Diehr*, 450 U.S. at 192) (emphasis in original). Indeed, the dispositive inquiry is whether the claim *as a whole* is directed to statutory subject matter, it is irrelevant that a claim may contain, as part of the whole, subject matter that would not be patentable by itself. *Id.*

Although the Applicant does not agree with the Examiner's assertions, independent claims 1, 21 and 26 have nonetheless been amended to further clarify the claimed subject matter. Specifically, with regard to claims 1 and 21, the Applicant has included the phrase "that is stored in memory," which relates to the model of preferences that is being evolved based upon the fitness measure. With regard to claim 26, the Applicant has included the phrase "that are stored in memory" with regard to the sample set of pair-wise preferences. The evolution of these models is clearly useful to solving problems with tradeoffs between consumer preferences, as describes in the present application. *See* Application, page 1, lines 9-18. The use of the model of preferences is useful to decision makers, such as human beings, in e-commerce, product support systems, software distribution, and web servers, for example. *See* Application, page 3, lines 4-32; page 6, line 27 to page 7, line 29. Clearly, a person of ordinary skill in the art in the advertising, marketing, and web design fields would find models of preferences "useful" to effectively advertise, market, and design their

products. Accordingly, the Applicant respectfully submits that the pending claims are directed to statutory subject matter, and respectfully requests reconsideration and allowance of the pending claims.

II. Rejection Under 35 U.S.C. § 112

As mentioned above, the Examiner rejected claim 6 under 35 U.S.C. § 112 as containing subject matter that was allegedly not described in the specification. The Applicant respectfully traverses this rejection.

The test for enablement is set forth in M.P.E.P. § 2164.01. From that section, the test for enablement appears to be whether one skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art *without undue experimentation*. *See Mineral Separation v. Hyde,* 242 U.S. 261, 270 (1916). In order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. M.P.E.P. § 2164.04. Thus, the Examiner's rejection should provide factors, reasons, and evidence that lead the Examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation. *Id.* Further, detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention.

In the rejection, the Examiner stated that claim 6 recites subject matter that is not described in such a way that to enable one skilled in the art to which it pertains. This unsupported assertion by the Examiner does not satisfy the evidentiary requirements set forth

in M.P.E.P. § 2164 and the legal precedents cited above. Indeed, the Examiner has not provided factors, reasons, and evidence to support the Examiner's assertion that the specification fails to teach how to make and use the claimed invention without undue experimentation. As such, the Examiner has not met the burden of establishing a reasonable basis to question the enablement provided for the claimed subject matter.

In fact, contrary to the Examiner's assertions, the candidate models in the present application are clearly described throughout the specification to enable one skilled in the art to make or use the invention. Specifically, the passages on page 10, line 5 to page 14, line 24 describe the exemplary embodiments of the models. These models are even described to include computer programs, mathematical expressions, neural networks, and belief networks. *See* Application, page 10, lines 15-22. As such, the Applicant respectfully submits that claim 6 is clearly enabled in the present application. Accordingly, the Applicant respectfully requests withdrawal of the Examiner's rejection of claim 6.

III. First Rejection Under 35 U.S.C. § 102

The Examiner rejected claims 1-24, 26-29, and 31 under 35 U.S.C. §102 (b) as being anticipated by the Nomura reference. Specifically, the Examiner stated:

> **Nomura et al. disclose an** inference knowledge extracting apparatus capable of being adapted to a change of input/output data. In a fuzzy rule individual group storing section is stored a group of individuals having a gene string associated with a fuzzy rule of a fuzzy rule storing section by a fuzzy rule gene associating section. A fuzzy rule individual selecting section stochastically selects individuals having a small output error with respect to the input/output data based on a calculation result of fitness obtained by an individual fitness calculating section. A fuzzy rule individual gene manipulating section executes a gene manipulating operation on each individual selected by the individual fitness calculating section.

> The fuzzy rule gene associating section, individual fitness calculating section, fuzzy rule individual selecting section, fuzzy rule individual gene manipulating section and a rule weight deciding section are functioned, thereby executing an evolutionary adaptation operation to extract a fuzzy rule that is evolutionarily adapted to the change of the input/output data. See particularly, fig. 5-11, 14, 16 and associated text; col. 1.

Paper No. 3, pages 6-7.

The Applicant respectfully traverses this rejection. Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In order to maintain a proper rejection under section 102, a single reference must teach each and every element or step of the rejected claim, else the reference falls under section 103. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicant need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention "*in as complete detail as contained in the ... claim*" to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

In the present case, Nomura does not anticipate the pending claims because the Nomura reference fails to disclose all of the claimed subject matter. For example, independent claim 1 recites "obtaining a sample set of pair-wise preferences among a subset of the alternatives" and "evaluating the candidate models using a fitness measure which is based on the sample set of pair-wise preferences." Independent claim 21 recites "using a

model of preferences of a target audience wherein the model that is stored in memory is evolved by iteratively generating a set of candidate models and evaluating the candidate models using a fitness measure which is based on a sample set of pair-wise preferences." Independent claim 26 recites "evaluating the candidate models using a fitness measure which is based on a sample set of pair-wise preferences that are stored in memory."

In contrast, Nomura merely discloses an inference knowledge extracting apparatus capable of being adapted to a change of input/output data. The knowledge extracting apparatus performs evolutionary adaptation by way of input/output data. *See* Normura, col. 2, lines 48-57. The evolutionary adaptation type inference knowledge extracting apparatus 1 includes a fuzzy rule extracting section 4. *See* Normura, col. 7, lines 42-47. The apparatus selects individuals based on the degree of fitness that is calculated for each individual. *See* Normura, col. 7, lines 48-67. Clearly, Nomura does not teach or suggest obtaining a sample set of pair-wise preferences among a subset of the alternatives, mush less evaluating the models using a fitness measure which is based on the sample set of pair-wise preferences. Thus, *Nomura* clearly does not disclose or suggest obtaining or utilizing pair-wise preferences, as recited in the present claims.

For at least the reasons set forth above, the Applicant respectfully submits that independent claims 1, 21, and 26 and the respective dependent claims are not anticipated by Nomura. Accordingly, the Applicant respectfully requests withdrawal of the Examiner's rejection of claims 1-24, 26-29, and 31 based upon the Nomura reference. Additionally, the Applicant respectfully asserts that claims 1-24, 26-29, and 31 are in condition for allowance.

IV. Second Rejection Under 35 U.S.C. § 102

The Examiner rejected claims 1-32 under 35 U.S.C. §102 (b) as being anticipated by the Terano reference. Specifically, the Examiner stated:

> Terano et al disclose the use of inductive learning and **genetic algorithms** with interactive and automated phases. The basic idea of the method is to integrate inductive learning to acquire **decision trees** or sets of decision rules and **genetic algorithms** to get the effective features to develop simple, easy-to-understand, and accurate knowledge from noisy data. The unique characteristic of the method is that the offspring (**decision trees**) are evaluated by both human-in-a-loop phase (simulated breeding) and automated simple GA-based phase. The proposed method has been qualitatively and quantitatively validated by a case study on consumer product questionnaire data of 2400 entries with 16 attributes. See particularly fig. 1 and associated text.
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> Paper No. 3, page 7.

The Applicant respectfully traverses this rejection.

As a preliminary matter, under 37 C.F.R. § 1.104(d)(1), the Examiner must provide the published date and published location of the printed publication. That is, the publication date for a cited reference must be provided to establish that a reference is valid prior art. Further, for an electronic publication, it is considered to be a printed publication provided that the publication was accessible to persons concerned with the art. *In re Wyer*, 655 F.2d 221, 227, 210 U.S.P.Q. 790 (C.C.P.A. 1981). Specifically, M.P.E.P. § 2128 states that if an electronic publication does not include the publication date, it cannot be relied upon as prior art. Thus, without a publication date, the Terano reference is not valid prior art.

In the Official Action, the Examiner fails to establish a publication date for the Terano prior to the Applicant's filing date and, as such, it is not valid prior art. The Terano reference does not

include a publication date within the reference. Further, the Examiner did not even provide a publication date for the Terano reference in the Notice of References Cited. As a result, the Examiner has provided no evidence that the Terano reference was published before April 7, 2000, which is the filing date of the present application. Thus, as noted above, the Terano reference does not qualify as prior art under M.P.E.P. § 2128 because no publication date before the filing date present application has been established. Accordingly, if the Examiner chooses to rely on this reference, the Applicant respectfully requests that the Examiner properly establish the publication date in accordance with the M.P.E.P. § 2128.

Despite the fact that the Terano reference is not valid prior art, the Applicant has attempted to ascertain which, if any, portions of the Terano reference may be relevant to formulate a response to make a good faith attempt at advancing prosecution of the present application. The Terano reference does not anticipate the pending claims because the Terano reference fails to disclose all of the claimed subject matter in the independent claims 1, 21, and 26. For example, independent claim 1 recites "obtaining a sample set of pair-wise preferences among a subset of the alternatives" and "evaluating the candidate models using a fitness measure which is based on the sample set of pair-wise preferences." Independent claim 21 recites "using a model of preferences of a target audience wherein the model that is stored in memory is evolved by iteratively generating a set of candidate models and evaluating the candidate models using a fitness measure which is based on a sample set of pair-wise preferences." Independent claim 26 recites "evaluating the candidate models using a fitness measure which is based on a sample set of pair-wise preferences that are stored in memory."

In contrast to the claimed subject matter, Terano merely discloses a method of assisting marketing decision makers in interpreting noisy questionnaire data. *See* Terano, Introduction. The reference utilizes an interactive phase to evaluate decision trees and an automated phase to develop offspring. *See id.* The interactive phase generates sets of decision trees with selected features. *See* Terano, Algorithm for Acquiring Decision Rules. Then, a domain expert selects two "good" decision trees or two "good" rules. *See id.* As a result, Terano does not teach or suggest obtaining a sample set of pair-wise preferences among a subset of the alternatives, mush less evaluating the models using a fitness measure which is based on the sample set of pair-wise preferences. Rather, Terano describes that the domain expert selects two rules from a set of rules or two decision trees from a set of decision trees. *See* Terano, Algorithm for Acquiring Decision Rules. Nothing in the reference discloses or suggests obtaining pair-wise preferences or using the pair-wise preferences to evaluate the candidate models. Thus, Terano clearly does not disclose or suggest the claimed subject matter.

For at least the reasons set forth above, the Applicant respectfully submits that independent claims 1, 21, and 26 and the respective dependent claims are not anticipated by Terano. Accordingly, the Applicant respectfully requests withdrawal of the Examiner's rejection of claims 1-32 based upon the Terano reference. Additionally, the Applicant respectfully asserts that claims 1-32 are in condition for allowance.

V. Third Rejection Under 35 U.S.C. § 102

The Examiner rejected claims 1-24, 26-29, and 31 under 35 U.S.C. §102 (b) as being anticipated by the Martinka reference. Specifically, the Examiner stated:

> **Martinka et al. disclose** an inference knowledge extracting apparatus capable of being adapted to change of input/output data. In a fuzzy rule individual group storing section is stored a group of individuals having a gene string associated with a fuzzy rule gene associating section. A fuzzy rule individual selecting section stochastically selects individuals having a small output error with respect to the input/output data based on a calculation result of fitness obtained by an individual fitness calculating section. A fuzzy rule individual gene manipulating section executes a gene manipulating operation on each individual selected by the individual fitness calculating section. The fuzzy rule gene associating section, individual fitness calculating section, individual fitness calculating section, fuzzy rule individual gene manipulating section and a rule weight deciding section are function, thereby executing an evolutionarily adapted operation to extract a fuzzy rule that is evolutionarily adapted to the change of the input/output data. See particularly fig. 2-3 and associated text; col. 9, line 26 to col. 17, line 4.

Paper No. 3, pages 7-8.

As a preliminary matter, the Applicant notes that the Examiner has essentially paraphrased the abstract from the Normura reference, which is not the art being cited in this rejection, as the basis for the rejection. Specifically, the Normura abstract recites:

> There is provided an inference knowledge extracting apparatus capable of being adapted to a change of input/output data. In a fuzzy rule individual group storing section is stored a group of individuals having a gene string associated with a fuzzy rule of a fuzzy rule storing section by a fuzzy rule gene associating section. A fuzzy rule individual selecting section stochastically selects individuals having a small output error with respect to the input/output data based on a calculation result of fitness obtained by an individual fitness calculating section. A fuzzy rule individual gene manipulating section executes a gene manipulating operation on each individual selected by the individual fitness calculating section. The fuzzy rule gene associating section, individual fitness calculating section, fuzzy rule individual selecting section, fuzzy rule

> individual gene manipulating section and a rule weight deciding section are functioned, thereby executing an evolutionary adaptation operation to extract a fuzzy rule that is evolutionarily adapted to the change of the input/output data.

Normura et al., abstract.

Further, the Examiner has simply cited to multiple columns of the Martinka reference without any specific citations within the reference. The Applicant believes that these citations are entirely inadequate to fulfill the Examiner's obligations under 37. C.F.R. § 1.104(c)(2), which requires the Examiner to designate as nearly as practicable the particular part of the reference relied upon by the Examiner. Indeed, the Examiner is required to state the reasons for any adverse action or any objection. *See* 37 C.F.R. § 1.104(c)(2). Further, "[w]hen such prior art is cited, its pertinence should be explained." M.P.E.P. 707.05; *see* 37 C.F.R. § 1.104(c)(2). As such, the Applicant believes the rejection provided by the Examiner to be deficient on its face. Accordingly, Applicants request the Examiner provide as nearly as practicable a clear explanation of any future adverse action on this point.

Nevertheless, in order to make a good faith attempt at advancing prosecution of the present application, the Applicant has attempted to ascertain which, if any, portions of the Martinka reference may be relevant to formulate a response. However, after reviewing the entire reference of Martinka, the Applicant does not believe it discloses what the Examiner suggests. The Martinka reference does not anticipate the pending claims because Martinka fails to disclose all of the claimed subject matter. For example, independent claim 1 recites "obtaining a sample set of pair-wise preferences among a subset of the alternatives" and "evaluating the candidate models using a fitness measure which is based on the sample set of pair-wise preferences." Independent claim 21 recites "using a model of preferences of a

target audience" and "evaluating the candidate models using a fitness measure which is based on a sample set of pair-wise preferences." Independent claim 26 recites "evaluating the candidate models using a fitness measure which is based on a sample set of pair-wise preferences that are stored in memory."

The Martinka reference merely discloses an apparatus for determining one or more solutions to a problem. *See* Martinka, col. 3, lines 41-42. The apparatus comprises code for traversing a path within a problem tree that includes multiple decision paths. *See* Martinka, col. 3, lines 42-50. The reference simply describes traversing the tree to test premises to determine the proper conclusion for a problem. *See* Martinka, Fig. 4; col. 5, lines 26-54. Clearly, Martinka does not teach or suggest obtaining a sample set of pair-wise preferences among a subset of the alternatives. In addition, Martinka does not disclose evaluating the models using a fitness measure that is based on the sample set of pair-wise preferences. Rather, Martinka describes a compositional decision support reasoning system that utilizes *a root node*, which is "the first node for all decision paths in the given pursuit." *See* Martinka, col. 5, lines 26-31. In this manner, each node from the root node is processed to further verify the conclusion. *See* Martinka, col. 5, lines 31-54. Thus, Martinka clearly does not disclose or suggest obtaining or utilizing pair-wise preferences, as recited in the present claims.

For at least the reasons set forth above, the Applicant respectfully submits that independent claims 1, 21, and 26 and the respective dependent claims are not anticipated by Martinka. Accordingly, the Applicant respectfully requests withdrawal of the Examiner's rejection of claims 1-24, 26-29, and 31 based upon the Martinka reference. Additionally, the Applicant respectfully asserts that claims 1-24, 26-29, and 31 are in condition for allowance.

VI. Rejection Under 35 U.S.C. § 103

The Examiner rejected claims 25, 30, and 32 under 35 U.S.C. §103(a) as being rendered obvious by the Nomura reference in view of the Terano reference and in further view of Applicant's Own Admission. The Applicant respectfully traverses the rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (P.T.O. Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, the Examiner must provide objective evidence, rather than subjective

belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

Again, as a preliminary matter, which is noted above, the Terano reference does not qualify as prior art under M.P.E.P. § 2128 because no publication date is established before the filing date present application. Because the Terano reference is not valid prior art, it is improper to combine the Terano reference with the Nomura reference and Applicant's Own Admission. Thus, if the Examiner chooses to rely on this reference as part of the combination, the Applicant respectfully requests that the Examiner properly establish the publication date in accordance with the M.P.E.P. § 2128.

Claim 25 depends from independent claim 21 and claims 30 and 32 depend from independent claim 26. Each of these claims is asserted to be patentable at least based upon their dependency from the independent claims 21 and 26. In the rejection, the Examiner admitted that the Nomura and Terano references fail to expressly disclose the intended use for the decision making process. In an attempt to remedy the deficiencies, the Examiner relied upon the theory of inherency and alleged admissions by the Applicant in the "Background of the Invention" section of the present application. However, the Examiner's inherency arguments and alleged admissions by the Applicant do not cure the deficiencies of the Nomura and Terano references, as discussed above. Therefore, claims 25, 30, and 32 are patentable by virtue of their dependency on independent claims 21 and 26. Accordingly, the Applicant respectfully requests withdrawal of the rejection and allowance of claims 25, 30, and 32.

VII. New Claims

The Applicant has added new claims 33-38. With regard to the new claims, the Applicant respectfully asserts that these new claims are fully supported by the specification and do not recite new matter. Further, the Applicant contends that new claims 33-38 are allowable over the prior art of record for at least the reasons discovered above with regard to claims 1-32. Therefore, the Applicant respectfully request allowance of new claims 33-38.

Conclusion

In view of the amendments and remarks set forth above, the Applicant respectfully requests that the Examiner withdraw all rejections of the Applicant's pending claims 1-32 and allowance of claims 1-32 and new claims 33-38. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: August 2, 2004

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